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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,314	06/21/2005	Yoshimi Enomoto	JP 020028	1618

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EXAMINER	
ZHAO, DAQUAN	
ART UNIT	PAPER NUMBER
2621	
MAIL DATE	DELIVERY MODE
07/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/540,314	ENOMOTO, YOSHIMI	
	Examiner	Art Unit	
	DAQUAN ZHAO	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/21/2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 June 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-8 are rejected under 35 U.S.C. 101 because claims are directed to non-statutory subject matter.

Claims 7-8 are directed to a program per se, which are considered to non-statutory subject matter. In contrast, a claimed computer- readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Claims 7-8 recite a "program", which the examiner believes it is a software program. However, there's no software program can be found through out the specification of instant application.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al (U.S. 7,254,312 B2).

7. for claim 1, Yamada et al teach a data recording/reproducing device provided with a processor for receiving data including analog video data and additional information to control a copy of the video data and for processing the data, characterized in that said processor (e.g. figure 2, column 5, lines 5-13, A/D converter converts the analog video signal to digital signal, column 1, lines 22-32 and figure 14 shows the additional information to for copy protection) comprises:

a storage capable of storing the received video data (e.g. column 6, lines 7-23, programs are selected and recorded under the control of a remote controller);

means for instructing to start storing the video data in the storage when the additional information with a copy prohibiting information is received (e.g. column 6, line 57- column 7, line 10, the recording process is continued until the instruction for the recording prohibition is received when the copy control data is "11". The examiner recognizes this "instruction" is from the user with the remote controller since the recording process is controlled by the remote controller and "the recording prohibiting process is executed" for getting the "instruction" of the user from the On-Screen Display. Therefore, video can still be temporarily recorded when the video is copy protected);

means for instructing to start reproducing the video data stored in the storage before end of said storing (e.g. column 1, lines 50-60, or column 7, lines 10-35, time shift replay); and

means for erasing the video data in the storage immediately after information of the end of Storing is received (e.g. column 7, lines 37-47, the temporal recording is not executed when the broadcasting program ended, and the temporal recorded data is deleted. The examiners consider the timing from step "s53" to step "s57" is "immediately" since these steps are controlled by the micro-controller 221).

Claims 3, 5, 7 and 8 are rejected for the same reasons as discussed in claim 1 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 2, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al (US 7,254,312) as applied to claims 1, 3, 5, 7 and 8 above, and further in view of Yoshida et al (EP 1,256,950).

10. For claims 2, 4 and 6, Yamada et al fail to teach means for erasing the video data in the storage includes: means for erasing from the storage a reproduced portion of the video data in the storage immediately after reproduction; and means for erasing the video data in the storage when reproduction has not been started before the end of storing or when reproducing the video data is not being performed at the time of the end of storing. Yoshida et al teach means for erasing the video data in the storage includes: means for erasing from the storage a reproduced portion of the video data in the storage immediately after reproduction; and means for erasing the video data in the storage when reproduction has not been started before the end of storing or when reproducing the video data is not being performed at the time of the end of storing (e.g. paragraphs 612-613). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Yoshida et al into the teaching of Yamada et al to delete the video data after reproduction to prevent infringement of the copyright with respect to a program (Yoshida et al, paragraphs 24-25).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ueda et al (US 7,155,011); Kuno et al (6,584,552); Ogino et al (US 2001/0,028,714).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/
Examiner, Art Unit 2621
Daquan Zhao

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621